--26. The video data distribution device according to claim 1, wherein said data extractor extracts a reduced number of frames of the frame data comprised within the video data.--

REMARKS

Claims 1-26 are pending in the present application. Claims 1, 11, and 16 are independent.

CLAIM OBJECTIONS

In the outstanding Office Action, the Examiner has objected to the claims as containing two instances of claim 22. Applicant respectfully submits that the second instance of claim 22 has been relabeled as claim 26. Accordingly, withdrawal of this objection is respectfully requested.

35 U.S.C. §103(a) KATSEFF ET AL./SHIMODA REJECTION

Claims 1, 2, 4-9, 11-18, and 21-26 (as amended) stand rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,822,537 to Katseff et al. (hereafter Katseff) in view of U.S. Patent NO. 5,440,345 to Shimoda (hereafter Shimoda). This rejection, insofar as it pertains to the presently pending claims, is respectfully traversed for the following reasons.

In the Amendment filed by Applicant on December 4, 2000, Applicant argued that proper motivation for combining Katseff and Shimoda did not exist because the proposed modification of Katseff would render it unsatisfactory for

its intended purpose. Specifically, Applicant argued that Shimoda's disclosed data extractor maintains a constant transmission rate, which is in opposition to Katseff's intended purpose of dynamically varying the rate at which video frames are retrieved from a file server over a network.

In the Examiner's response to this argument in the outstanding Office Action, the Examiner asserts that both Katseff and Shimoda are in the field of video and audio processing, and that Katseff suggests the reduction of video transmission rate. The Examiner further asserts that one of ordinary skill in the art would realize this reduction of transmission rate by either reducing or compressing video data using a high efficient encoding/decoding technique as taught by Shimoda.

Applicants respectfully submit that the Examiner has failed to provide a showing of the teaching or motivation to combine Katseff and Shimoda. The CAFC has stated that rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references is the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis. In re Dembiczak, 50 USPQ2d 1614 (Fed. Cir. 1999). Evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of ordinary skill in the art, or in some cases, from the nature of the problem to be solved. Dembiczak at 1617.

The Prior Art References Themselves

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While Katseff discloses the distribution of audio and video data over a network, Katseff fails to disclose a data extractor. Although Shimoda discloses a data extractor for extracting intra-frame data from video data, Shimoda fails to disclose the monitoring of buffered audio and video data. As a result, Applicants respectfully submit that neither Katseff nor Shimoda provide a motivation for combining one with the other.

Nature of the Problem to be Solved

Applicant respectfully submits that Katseff solves the problem of dynamically varying the rate of retrieving video frames from a server in response to network traffic. Conversely, Shimoda solves the problem of providing a highly efficient encoding/decoding system suitable for recording and playing back broadcast video data. Applicant respectfully submits that the problems being solved are completely different, which is evidence of the non-combinability of the references.

Knowledge of One of Ordinary Skill in the Art

As suggested in Dembiczak, the last source for suggestion, teaching, or motivation could be the knowledge of one of ordinary skill in the art. Regardless of the source, the Examiner is still required to provide actual evidence. In particular, the showing must be clear and particular. Broad conclusory statements regarding the teaching of multiple references, standing

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alone are not evidence. Broad denials and conclusory statements are not sufficient to establish a genuine issue of material fact. Dembiczak at 1617.

On page 4 of the outstanding Office Action, the Examiner asserts that it would have been obvious one of ordinary skill to modify Katseff's system with Shimoda's data extractor, the motivation being "to provide necessary means for extracting an amount of frame data receiving [sic] from the previous step for video data processing purposes." Applicant respectfully submits that such a statement fails to show a proper motivation for combining Katseff and Shimoda, since one of ordinary skill in the art would realize that Shimoda's data extractor is not operable to extract an amount of data corresponding to a varying rate of transmission, as required by Katseff (see Katseff: column 2, lines 50-51; column 15, lines 30-55). As discussed in Applicant's prior amendment of December 4, 2000, Shimoda's data extractor can only extract frame data according to a constant transmission rate.

Applicant therefore respectfully submits that the proposed implementation of Shimoda's data extractor to Katseff's system would cause Katseff's file server to extract and transmit video frame data only at a constant transmission rate. This would render Katseff's system unsatisfactory for the intended purpose of dynamically varying the rate at which video frames are retrieved from the file server in response to network congestion.

MPEP §2143.02 explicitly states that "[i]f proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed

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modification." The same section of the MPEP also states that *prima facie* obviousness cannot be established if the proposed modification would require a change in the basic principle under which the primary reference construction was designed to operate. Applicant respectfully submits that the proposed modification of Katseff in view of Shimoda would render Katseff's invention unsatisfactory for its intended purpose and change the basic principle under which it was designed to operate.

Applicant respectfully submits that the Examiner has failed to establish a proper motivation, either from the references themselves, by virtue of the nature of the problem being solved, or by knowledge of one of ordinary skill in the art. Accordingly, Applicant submits that the Examiner has failed to establish a *prima facie* case of obviousness, and that claims 1, 2, 4-9, 11-18, and 21-26 are allowable. Reconsideration and withdrawal of the rejection is requested.

35 U.S.C. §103(a) KATSEFF/SHIMODA/TAKAHASHI REJECTION

Claims 3 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Katseff in view of Shimoda, and further in view of U.S. Patent No. 5,739,865 to Takahashi. This rejection is respectfully traversed for the following reasons.

On page 10 of the Office Action, the Examiner acknowledges that neither Katseff nor Shimoda teaches a data extractor that thins frame data based on a

processed load condition. The Examiner imports the teachings of Takahashi to remedy this deficiency.

Applicant respectfully submits that proper motivation does not exist for combining Katseff and Shimoda, for the reasons discussed above. In addition, Applicant submits that the Examiner has failed to establish a proper motivation for combining Takahashi with Katseff and Shimoda, as required in Dembiczak. On page 10 of the outstanding Office Action, the Examiner states that the motivation for such a combination is "to manipulate frame data as much as possible." Applicant respectfully submits that such a statement would not motivate one of ordinary skill to combine Takahashi with Katseff and Shimoda, because the manipulation of data does not, in itself, provide any discernable advantages or benefits.

Further, Applicant respectfully submits that Takahashi teaches the thinning-out of frames in order to allow a video signal to be shown on NTSC or PAL television systems. Takahashi discloses absolutely nothing with respect to thinning out frames according to a processed load condition. Accordingly, the proposed combination fails to teach the thinning of frame data based on a load condition processed by a load processing device, as required by claims 3 and 10. Accordingly, Applicant respectfully submits that claims 3 and 10 are allowable. Reconsideration and withdrawal of this rejection is respectfully requested.
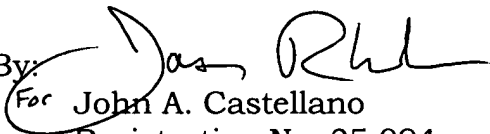
CONCLUSION

The Examiner is respectfully requested to enter this Request for Reconsideration. In view of the above remarks, reconsideration of the rejection of claims 1-18 and 21-25 is respectfully requested.

If the Examiner has any questions concerning this application, the Examiner is requested to contact John A. Castellano, Registration No. 35,094 at (703) 205-8000 in the Washington, D.C. area.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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